

REMARKS

Claims 7 and 8 are added, and therefore claims 1 to 8 are now pending.

Applicants respectfully requests reconsideration of the present application in view of this response.

Applicants respectfully request that the Examiner acknowledge the claim for foreign priority and the receipt of the certified copies of the priority documents from the International Bureau, and that the Examiner acknowledge and consider the IDS papers, PTO-1449 forms and the disclosed references filed on June 24, 2003.

With respect to paragraph one (1), claims 1, 2, 4 and 5 were rejected under 35 U.S.C. 103(a) as unpatentable over Ohgoshi, U.S. Patent No. 5,666,352, in view of Yamamoto, U.S. Patent No. 6,252,914.

The "Ohgoshi" reference refers to a mobile CDMA communication system and a method for phase correction, in which, as characterized, the signals to be sent from a base station with the aid of a first oscillator are subjected to quadrature multiplexing. Upon receipt, an additional oscillator in each mobile station implements a quadrature detection and operates asynchronously to the first oscillator, so that signal-value errors result in the receiving signals due to a phase shift (column 2, lines 38 to 47). As characterized, with the transmission of reference signals in the form of pilot signals, the phase errors in the receiver are detected, averaged and used for phase correction of the transmitted data.

The "Yamamoto" reference refers to a radio-communication system in which a predistortion of the signals to be sent is implemented in the base station.

In contrast, the subject matter of independent claim 1 (as well as independent claim 4) concerns the correction of phase shifts resulting from the predistortion of the signals to be transmitted from the base station to the mobile station, since the estimation of the transmission characteristics of the forward link is not correct because of the movement of the carrier of the mobile stations.

If the primary reference were combined with the secondary reference, this would only indicate that an asynchronism between the oscillator for the quadrature multiplexing in the base station and the oscillator for the quadrature detection in each mobile station would be corrected via phase correction by the transmission of pilot signals from the base station to the

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corresponding mobile station, but it would not compensate for the lack in reciprocity between the reverse link and the forward link. Accordingly, it is respectfully submitted that one faced with the task of compensating for the lack in reciprocity between the reverse link and the forward link in those cases where predistortion is utilized, would not consider the subject matter of the primary reference as to the subject matter of the secondary reference.

Also, other differences result between the subject matter of the applied references and the subject matter of claims 1 and 4. For example, in the primary reference, the phase shift is determined for a pilot signal to be transmitted. In contrast, the transmission of such a pilot signal is not even provided for in the context of the subject matter of claims 1 and 4, since the phase shift is determined for each symbol of the transmitted data.

Furthermore, with the subject matter of claims 1 and 4, the phases are mapped in the mobile station onto a phase zone in accordance with a preestablished rule. In this regard, for example, the present application makes plain that it is not the absolute position of the individual phases that is important, but is instead the deviation. Therefore, all phases are mapped onto a specific value and the deviation from this value then provides the phase error, which is used to correct the radio signals. It is respectfully submitted that the reference the Office Action made to Figure 10b in this context is not correct insofar as, according to column 3, lines 17 to 26 of the primary reference, Figure 10b only refers to the phase shift of the pilot signal that occurs during the transmission from a base station to the mobile station. This, however, does not in any way concern the implemented mapping of the phases of the symbols onto a phase zone in accordance with a preestablished rule, as recited in the context of claims 1 and 4.

It is therefore respectfully submitted that claims 1 and 4 are allowable, as are their respective dependent claims 2, 3 and 5, 6.

With respect to paragraph two (2), claims 3 and 6 were rejected under 35 U.S.C. 103(a) as unpatentable over Ohgoshi, U.S. Patent No. 5,666,352, in view of Rakib, U.S. Patent No. 6,356,555.

Claims 3 and 6 respectively depend from claims 1 and 4, and are therefore allowable for the same reasons as their respective base claims, since any review of the secondary reference makes plain that it does not cure the critical deficiencies of the primary reference.

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Accordingly, claims 3 and 6 are allowable.

As further regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that the references even if combined would not solve the problems met by the presently claimed subject matter, as referred to in the present application.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), refer to when an Office Action’s assertions that it would have been obvious to modify the reference relied upon will not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that if the Office Action reflects a subjective “obvious to try” standard, it does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to

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make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). More recent still, in the case of In re Lee, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

*With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. **This factual question of motivation is material to patentability, and could***

not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for “any specific hint or suggestion in a particular reference” to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

[The] “common knowledge and common sense” on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.

[The] Board's findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

In view of the foregoing, it is respectfully submitted that claims 1 to 6 are allowable.

New claims 7 and 8 do not include any new matter and are supported in the specification. New claim 7 depends from claim 4, and new claim 8 depends from claim 1, and are therefore allowable for the same reasons as their respective claims 4 and 1. New claims 7 and 8 include features like those of claims 5, 6 and 2, 3, respectively.

Accordingly, claims 1 to 8 are allowable.

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CONCLUSION

In view of the above, it is believed that the the rejections have been obviated, and it is therefore respectfully submitted that claims 1 to 8 are allowable. It is therefore respectfully requested that the rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,

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